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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/898,853 07/25/97 YAMAGISHI

H Q45980

EXAMINER

QM12/0928

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2100 PENNSYLVANIA AVENUE N W
WASHINGTON DC 20037-3202

GORDON, R	
ART UNIT	PAPER NUMBER

3711
DATE MAILED:

09/28/01

39

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/898,853

Applicant(s)

Yamagishi et al.

Examiner

Raeann Gorden

Art Unit

3711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 12, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 is/are allowed.
- 6) ☒ Claim(s) 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit:

DETAILED ACTION

Claim Rejections - 35 U.S.C. § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 13-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not substantially disclose a third layer on the core of the golf ball. There is an option of providing additional layers (spec 9 line 5) but there are no specific details given regarding the characteristics. Particularly there is no mention of the Shore D hardness being less than the second layer (claim 13) or the thickness (claim 15). (The shore D hardness of the core inner layer is not lower than 20 and the diameter is not lower than 20 mm according to the specification (p 6 line 31 and p 7 line 1) yet, the limitations of claims 14-15 fall beneath these values.) Furthermore, there is no mention of the specific gravities in claim 16 or the materials in claim 18.

Art Unit:

Allowable Subject Matter

3. Claims 1-12 are allowed.

Response to Arguments

4. Applicants' argument is based on the premise that although two core layers and two cover layers were originally disclosed in the instant application, the innermost cover layer may nevertheless be considered simply an outermost core layer. Applicants state that there is no substantial difference between what has been disclosed as an inner cover layer, and, what the patent with which applicants seek to provoke an interference, discloses as an outer core layer, citing similar materials and compositions in the compared layers. However, this position is at odds with that taken by the applicants in paper 6 where applicants argued that prior art showing a three piece core and a cover is "*completely distinguishable*" from the ball of the applicants' claims, (emphasis added). (See paper 6 remarks pages 4-6). These remarks were made in an attempt to overcome a prior art rejection. Under file wrapper estoppel doctrine applicants are estopped from now arguing that the inner cover layer may be considered an outer core layer or vice-versa.

Applicant may contact the Examiner at anytime to schedule an interview.

Art Unit:

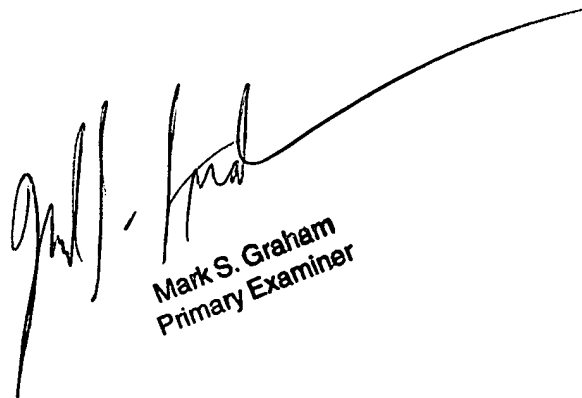
Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is (703) 308-8354. The examiner can normally be reached Monday-Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeanette Chapman, can be reached on 703-308-1310. The fax number for the organization where this application or proceeding is assigned is 703-308-7768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

RG
September 24, 2001


Mark S. Graham
Primary Examiner